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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,095	02/11/2004	Craig D. Johnson	68.0230CNT1	2344

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EXAMINER
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COLLINS, GIOVANNA M

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



## Office Action Summary

Application No.

10/776,095

Applicant(s)

JOHNSON ET AL.

Examiner

Giovanna M. Collins

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29,31-36,43-58 and 74-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 74-79 is/are allowed.
- 6) ☐ Claim(s) 29,31-36,43-49 and 51-58 is/are rejected.
- 7) ☒ Claim(s) 50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Objections*

1. Claims 31-36 are objected to because claim 31 recites the limitation "the tubular member" in line 2. There is insufficient antecedent basis for this limitation in the claim as this limitation has not been previously recited.

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 29, 31-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-33 of U.S. Patent No. 6,695,054.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the application limitations although broader are obviously met by the patent which discloses a expandable tubular with a locking means, and a base pipe, shroud and a plurality of overlapping filter sheets as recited in the claims.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 29,31-34 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Teague et al. 2,812,025.

Teague discloses (fig. 6) an expandable tubular system have a first layer (at 26b) overlapping a second layer (at 14b) and a locking mechanism (at 30 and 32) which facilitates maintaining the tubular system in the expanded condition (col. 4, lines 35-48).

Referring to claim 31, Teague discloses the first and second layers are formed of filter material (col. 3, lines 25-27) wrapped around a tubular member (14).

Referring to claim 32, Teague discloses the locking mechanism (30,32) is coupled to the first and second layers.

Referring to claim 33, Teague disclose the locking mechanism is ratchet teeth (30,32).

Referring to claim 34, Teague discloses the locking mechanism is detents (30,32).

Referring to claim 36, Teague discloses the locking mechanism is a plurality of vanes (30,32).

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5. Claims 43-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Lohbeck 5,366,012.

Lohbeck discloses (fig 2) delivering a sand screen to a wellbore region having a non uniform diameter (uncased wellbores regions inherently do not have a uniform diameter the entire length of the wellbore), applying an expansion force to the sand screen in a radially outward direction and expanding the sand screen to substantially eliminate any annulus between the sand screen and the wellbore region having the non uniform diameter (col. 4, lines 34-40).

Referring to claim 44, Lohbeck discloses expanding comprises creating contact between the sand screen and a wall defining the wellbore region (col. 4, lines 34-40).

Referring to claim 45, Lohbeck discloses expanding comprises applying an outwardly directed force (by element 15) against the wall with the sand screen.

Referring to claim 46, Lohbeck discloses wherein expanding comprises expanding the sand screen (11) into the wellbore region having two dissimilar diameters (uncased well bore region inherently have more than one dissimilar diameters).

Referring to claim 47, Lohbeck discloses applying comprises moving an expansion tool (15) through an interior of the sand screen.

6. Claims 48 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Echols 6,415,509.

Echols discloses a sand screen (fig. 3) having a plurality of expandable filter sections (40,44) and at least one seal section wherein the plurality of expandable filter section are longitudinally separated by the at least one seal section (56).

Referring to claim 51, Echols discloses the seal section has an expansion ratio at least as great as the expansion ratio of the plurality of expandable filter sections (col. 4, lines 44-50).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Teague '025 in view of Holmes 2,769,655.

Teague discloses the system of claim 29 but does not disclose locking mechanism comprises angled bristles. Holmes teaches that angled bristles are a friction creation means. As it would be advantageous to have a locking means to produces friction to keep tubular in an expanded position, it would be obvious to one of ordinary skill in the art to modify the system disclosed by Teague to have angled bristles as taught by Holmes.

9. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Echols et al. '509.

Echols discloses the system of claim 48 but does not specifically disclose a plurality of seal sections. However, duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA

1960). As it would be advantageous to have as many seal sections in order to maintain the screen in a tubular formation, it would be obvious to one of ordinary skill in the art to modify the system disclosed by Echols to have a plurality of seal section.

10. Claims 52-58 are rejected under 35 U.S.C. 103(a) as being obvious over Donnelly ('789) in view of Lohbeck '012.

Donnelly discloses a method of controlling filtration in a wellbore environment, comprising: arranging an expandable tubular system (Fig. 1) with overlapping filter sheets (4); Donnelly discloses the filter sheets have uniquely configured openings but does not disclose positioning uniquely configured openings in each overlapping filter sheet such that upon expansion of the expandable tubular system the overlapping filter sheets create a predetermined flow path regime. Lohbeck teaches positioning filters such that after expansion a predetermined flow is created to help prevent sand from entering borehole (col. 4, lines 1-10). As it would be advantageous to prevent sand from entering the bore hole it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Donnelly to positioning uniquely configured openings in each overlapping filter sheet such that upon expansion of the expandable tubular system the overlapping filter sheets create a predetermined flow path regime as taught by Lohbeck.

Referring to claim 53, Lohbeck teaches positioning comprises selecting the predetermined flow path regime to create a pressure drop that varies along the length of the expandable tubular system (col. 4, lines 1-10).

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Referring to claim 54, Lohbeck teaches positioning comprises selecting the predetermined flow path regime to create a greater restriction to flow in specific regions of the expandable tubular system relative to other regions of the expandable tubular system (col. 4, lines 1-10).

Referring to claim 55, Donnelly discloses the filter sheets are metal foil (see col. 5, lines 12-13).

Referring to claim 58, Donnelly discloses comprises forming the uniquely configured openings such that the openings in a first sheet (4) overlap the openings in a second sheet to create a unique combined openings upon expansion of the expandable tubular system.

11. Claims 56-58 are rejected under 35 U.S.C. 103(a) as being obvious over Donnelly ('789) in view of Lohbeck '012 as applied to claim 52, further in view of Whitlock 6,382,318.

Donnelly discloses the filter sheets can be different shapes but does not disclose that adjacent sheets have different shapes. However, Whitlock discloses that adjusting the structure of adjacent sheets selectively direct flow in certain areas is well known in the art (see col. 5, lines 51-60). Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to further modify the method disclosed by Donnelly to change the shape of the adjacent filter sheets as suggested by Whitlock because adjusting the structure of the filter layers to direct the flow is well known in the art.

Referring to claim 57, Donnelly discloses the filter sheets can have slots but does not disclose that adjacent sheets have slots at different angles. However, Whitlock discloses that



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adjusting the structure of adjacent sheets selectively direct flow in certain areas is well known in the art (see col. 5, lines 51-60). Therefore it would be obvious to one of ordinary skill in the art at the time of the invention further modify the method disclosed by Donnelly to change the angles of the slots of the adjacent filter sheets as suggested by Whitlock because adjusting the structure of the filter layers to direct the flow is well known in the art.

Referring to claim 58, Donnelly discloses comprises forming the uniquely configured openings such that the openings in a first sheet (4) overlap the openings in a second sheet to create a unique combined openings upon expansion of the expandable tubular system.

#### *Allowable Subject Matter*

12. Claims 74-79 are allowed.
13. Claim 50 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Response to Arguments*

14. Applicant's arguments with respect to claims 28,31-36,43-49,51-58 have been considered but are moot in view of the new ground(s) of rejection.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 703-306-5707. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
gmc

  
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